

Notice of Allowability

Application No.

09/728,179

Examiner

Joseph D. Anthony

Applicant(s)

ISHIDA ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.
2. ☒ The allowed claim(s) is/are 1-8 [renumbered as 1,3,5,7,2,4,6,8].
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 3 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other _____ |

Joseph D. Anthony
Primary Examiner
Art Unit: 1714

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Robert J. Jacobson on 11/10/03.

The application has been amended as follows:

Claims 1 (amended) A stabilized hydroxyalkyl acrylate or hydroxyalkyl methacrylate, [(meth)acrylate,] which comprises [contains] a hydroxyalkyl saturated-carboxylate and/or alkylene glycol along with a polymerization inhibiting phenol compound.

In claims 2-8, line 1 of each claim, delete "(meth)acrylate," and insert therefore -- acrylate or hydroxyalkyl methacrylate,--.

In claims 5-8, line 2 of each claim, delete "contains" and insert therefore --comprises--.

2. The following is an examiner's statement of reasons for allowance: The above examiner's amendment was made to clarify the scope of the pending claims. It is clear

from applicant's specification that the enabled invention encompasses the stabilization of hydroxyalkyl acrylate as well as the stabilization of hydroxyalkyl methacrylate, see applicant's examples. Since the term "(meth)acrylate" has different meanings in the art, such as limiting the acrylate to only those that have a methyl substitution, the examiner received permission to rewrite the claims so that they encompassed both embodiments of stabilization of hydroxyalkyl acrylate or hydroxyalkyl methacrylate.

The closest pieces of prior-art are deemed to be as followed:

A) Aldinger et al. U.S. Patent Number 4,368,320 teaches a process for the production of hydroxyl group containing caprolactone modified (meth)acrylate resin. Part (a) of examples 1-7 clearly teach that it is well known in the art to use a minor amount of hydroquinone monomethyl ether (corresponds to applicant's polymerization inhibiting phenol compound) as a stabilizer for the hydroxyethyl acrylate monomer. The only mention of applicant's hydroxyalkyl saturated-carboxylate stabilizing compound is found in Comparison Example 1 wherein 10.9 parts of 2-hydroxyethyl acetate is added during the copolymerization process of the monomers of part (a) of example 3. It is absolutely clear that the addition of 2-hydroxyethyl acetate to the monomers of part (a) of example 3 does not lead to applicant's claimed invention of a stabilized hydroxyalkyl acrylate or hydroxyalkyl methacrylate, which comprises a hydroxyalkyl saturated-carboxylate and/or alkylene glycol along with a polymerization inhibiting phenol compound since Comparison Example 1 is drawn to a process of polymerization of the

monomers which is the exact opposite of stabilizing the monomers from polymerization.

(B) Greff et al. U.S. Patent Number 6,102,205, Scheve U.S. Patent Number 4,198,238 and Restaino U.S. Patent Number 4,049,731 all teach that the stabilization of hydroxyalkyl acrylate or hydroxyalkyl methacrylate by the addition of a polymerization inhibiting phenol compound is known in the art, see column 6, lines 39-48 and column 5, lines 7-20 of Greff et al., Example 1 of Scheve, and abstract and column 8, lines 25-65 of Restaino. Applicant's invention is deemed to be patentable distinct over each of these references because there is absolutely no disclosure of any kind to the further addition of applicant's claimed hydroxyalkyl saturated-carboxylate and/or alkylene glycol components. There is thus no motivation for one having ordinary skill in the art to make applicant's claimed stabilized composition.

3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Prior-Art Cited But Not Applied

4. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (703) 308-0446 until 12/04/03; after 12/04/03 my new telephone number will be (571) 272-1117. This examiner can normally be reached on Monday through Thursday from 7:35 a.m. to 6:00 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0651. The receptionist is located on the 8th floor of Crystal Plaza 3 (e.g. CP-3) and will be the welcome point for all visitors to the building.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

11/11/03